

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PETROVIC et al.
Title: APPARATUS AND METHOD FOR EMBEDDING AND EXTRACTING
INFORMATION IN ANALOG SIGNALS USING DISTRIBUTED
SIGNAL FEATURES AND REPLICA MODULATION
Appl. No.: 10/763,288
Filing Date: 1/26/2004
Examiner: Paul E. Callahan
Art Unit: 2437
Confirmation Number: 6479

**REQUEST FOR RECONSIDERATION OF DISMISSAL
OF REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. §1.705**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the dismissal dated September 16, 2009 (hereinafter "Dismissal"). A fee was submitted with the original request for reconsideration of Patent Term Adjustment (PTA) of April 06, 2009. If a request for reconsideration is not appropriate, then this present request is a petition under 37 CFR sections 1.181, 1.182, and 1.183.

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 10/20/2009 as U.S. Patent No. 7,606,366.

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Applicants respectfully request reconsideration of the patent term adjustment (PTA) of 652 days as indicated on the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed on January 9, 2009. The total PTA should be adjusted by an additional 373 days, for a total of **1025 days**, as determined below. Specifically, the total PTA should be adjusted by (1) 101 days due to pendency beyond a 3-year period and (2) 272 days due to inaction by the USPTO.

PTA due to 3-year pendency period

Upon review of the Patent Term Adjustment History using the Patent Application Information Retrieval (PAIR) database, it is noted that Applicants should be credited an additional 101 days for USPTO delay beyond January 26, 2007 (the end of the three-year pendency period) through the date of the filing of a Request for Continued Examination on September 22, 2008.

Applicants believe that the PTA determination by the USPTO was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to an additional 101 days PTA.

PTA due to inaction by the PTO

An additional 272 days of PTA should be added due to inaction by the PTO from December 15, 2005 (4 months after the August 15, 2005 response to office action filed by Applicant) until the mailing of another non-final office action on September 13, 2006. While a final office action was issued on November 3, 2005, that office action was withdrawn by the Examiner pursuant to an Examiner Interview conducted on December 20, 2005, a summary of which is attached hereto as Exhibit A. No action was taken by the Examiner until the mailing of the office action on September 13, 2006.

Therefore, PTA credited to Applicants properly accrues for the period of time beginning 4 months following the filing of the response on August 15, 2005 (i.e., December 15, 2005) and ending with the mailing of the office action on September 13, 2006. Therefore, because the entire delay during that period of time is solely attributable to PTO inaction, an additional 272 days of PTA should be properly credited to Applicants.

In the Dismissal, it is argued that:

“The fact that the Office subsequently mailed a further Office action withdrawing the finality of the November 3, 2005 Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2) on November 3, 2005.”
Dismissal, Page 3.

Applicant respectfully notes that during the Examiner Interview conducted on December 20, 2005, the Examiner not only withdrew the finality of the Office action, but also withdrew the action itself. Specifically, the Examiner noted that he “agreed to lift the finality of the prior Office Action and issue a new Action applying new art.” Thus, withdrawal of the office action does, in fact, negate the action taken by the USPTO on November 3, 2005.

Conclusion

Therefore, the net Patent Term Adjustment should be **1025 days**, based on 652 days already acknowledged on PAIR, plus 373 days as noted above (101 days plus 272 days). Accordingly, it is respectfully requested that the total patent term adjustment of **1025 days** be issued in favor of the Applicant. This patent is not subject to a terminal disclaimer.

A fee was submitted with the original request for reconsideration of Patent Term Adjustment (PTA) of April 06, 2009. Thus, Applicant believes no fee is due. However, if the Patent Office determines that a fee is required, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application for patent term adjustment can be achieved.

The patent is not subject to a terminal disclaimer.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date November 13, 2009

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